

### Remarks

Claims 24, 26-33, 41-50 and 52 are pending in this application.

### Double Patenting

The Examiner rejected claims 24, 26-33, 41-50 and 52 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent 5,330,754. Applicant respectfully traverses the double-patenting rejection.

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In *re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In *re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In *re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). MPEP 804.

Claim 1 of the '754 patent recites a purified *M. bovis* BCG protein whose amino acid sequence is represented in SEQ ID NO: 2. Claims 2-4 of the '754 patent are dependent on claim 1 and recite homologs of the protein of SEQ ID NO:2.

Claims 24, 26-33, 41-50 and 52 of the present application are directed to methods of detecting the presence of antibodies that bind to a protein with the amino acid sequence of SEQ ID NO:2 or to a homolog of SEQ ID NO:2.

Claims 24, 26-33, 41-50 and 52 of the present application are patentably distinct from claims 1-4 of the '754 patent. Claims directed to a protein clearly do not teach or suggest antibodies to such a protein. The pending claims of the present application are to methods for detecting such antibodies in a biological sample. The pending claims are therefore twice removed from the subject matter claimed in the '754 patent.

Therefore, claims 1-4 of the '754 patent cannot render claims 24, 26-33, 41-50 and 52 of the present application obvious. Applicant respectfully requests withdrawal of the double-patenting rejection.

### CONCLUSION

On the basis of the amendments and remarks presented herein, Applicants believe that this application is now in condition for immediate allowance. Applicants respectfully request that the Examiner pass this application to issue, and an early notice of such is requested. The Examiner is invited to call the undersigned attorneys for discussion of any outstanding issues.

Respectfully submitted,  
DORSEY & WHITNEY LLP

Date: January 26, 2004

Suite 3400, Four Embarcadero Center  
San Francisco, California 94111-4187  
(415) 781-1989



Richard F. Trecartin (31,801)  
*Filed under 1.34 (a)*  
*Customer No. 32940*